

UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA  
SAN JOSE DIVISION

DCG SYSTEMS, INC.,

Plaintiff,

v.

CHECKPOINT TECHNOLOGIES, LLC,

Defendant.

Case No.: 11-CV-03792-PSG

**ORDER DENYING DEFENDANT'S  
MOTION TO INCREASE THE  
NUMBER OF CLAIM TERMS FOR  
CONSTRUCTION AND GRANTING  
DEFENDANT'S ALTERNATIVE  
MOTION TO REDUCE THE  
NUMBER OF ASSERTED CLAIMS**

**(Re: Docket No. 48)**

Defendant Checkpoint Technologies, LLC ("Checkpoint") moves to increase the number of claims to be construed from ten to twenty-three. Plaintiff DCG Systems, Inc. ("DCG") opposes the motion. Pursuant to Civ. L.R. 7-1(b) and at Checkpoint's own request, the motion is taken under submission without oral argument. Having reviewed the papers and considered the arguments of counsel,

IT IS HEREBY ORDERED that Checkpoint's motion to increase the number of claims to be construed is DENIED and Checkpoint's alternative motion to reduce the number of asserted claims is GRANTED.

DCG accuses Checkpoint of infringing fifty-seven claims in seven patents.<sup>1</sup> The seven patents come from four families, each with their own file history and distinct specifications. As

<sup>1</sup> DCG has filed a motion for leave to serve amended infringement contentions that drop six claims and add four others, bringing the total to fifty-five asserted claims. *See* Docket No. 53.

1 reflected in the parties' exchange of proposed claim terms, DCG does not identify a single term  
 2 that it believes required construction. It merely contends that one term should be governed by 35  
 3 U.S.C. § 112(6) and that the plain and ordinary meaning of all the remaining terms is adequate to  
 4 the task.

5 Checkpoint on the other hand identifies twenty-three claim terms for construction, citing  
 6 the number of patents DCG has put at issue, the nature of the terms themselves, and the context  
 7 within which the terms are used. Checkpoint alternatively urges that DCG be limited to no more  
 8 than ten asserted claims.

9 On the number of claim terms to be construed, DCG has the better of the argument. The  
 10 patent local rules limit to ten the number of terms to be construed, and for good reason.<sup>2</sup> Without  
 11 such a limit, the court faces a glut of terms that threatens the efficiency of the claim construction.  
 12 While there is no particular magic to the rule's ten – term limit, here both parties agreed during the  
 13 case management conference held on November 1, 2011 that the court would construe no more  
 14 terms than that. Not only would the scale of the parties' claim construction briefing be impacted by  
 15 Checkpoint's proposal but the *Markman* hearing itself would prove unwieldy. As it is, the court has  
 16 allotted seven hours for a hearing on ten disputed claim terms.<sup>3</sup>

17 The more appropriate way to mitigate the burden identified by Checkpoint is to adapt a  
 18 variant of its alternative proposal. No jury in this case is going to resolve 57 patent claims, and  
 19 there is no legitimate reason not to begin work now on whittling that number down to something  
 20 manageable. At the same time, the court appreciates that the parties are presently in the midst of  
 21 claim construction briefing. To balance these considerations, in the joint case management report  
 22 due 30 days after the claim construction ruling, DCG shall identify the 25 claims on which it  
 23 wishes to proceed. This itself may not be the final cut, but it is a reasonable start down that road. In


24 <sup>2</sup> See Pat L.R. 4-3(c). DCG notes that many judges in this district, including Judges White,  
 25 Armstrong, Gonzalez-Rogers and Hamilton, further impose specific limits on claim terms in their  
 26 standing orders. To the extent that after the claim construction ruling there remains a fundamental  
 27 dispute for the court to resolve regarding the meaning of an outstanding term, the court will fulfill  
 28 its duty in accordance with *O2 Micro Int'l Ltd. v. Beyond Innovation Tech. Co.*, 521 F.3d 1351  
 (Fed. Cir. 2008), *Finjan, Inc. v. Secure Computing Corp.*, 626 F.3d 1197, 1207 (Fed. Cir. 2007)  
 and *Conoco, Inc. v. Energy & Env't'l, L.C.*, 460 F.3d 1249, 1359 (Fed. Cir. 2006).

<sup>3</sup> See Docket No. 71.

advance of the expert reports, the court will entertain a request to further reduce the set of asserted claims.

**IT IS SO ORDERED.**

Dated: 4/13/2012



PAUL S. GREWAL  
United States Magistrate Judge